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REMARKS

Claims 10, 14, and 18 are amended to overcome the examiner's objections. The claim amendments include several of the examiner's suggestions for correction. The suggested deletion of "second" from claims 10 and 14 was not adopted. Instead, those claims were amended to recite "a second housing defining a transmission housing," which was what was intended and was why a comma was earlier placed after "second." The claims already recite a first housing, and the deletion of "second" would have suggested that "first" also be deleted as unnecessary.

Claims 2, 5 through 9, 10 through 14, 16, and 18 through 28 8 through 10 were rejected as obvious over the Fischer et al. '178 and the Bachnak et al. '056 references.

The following are observations concerning the examiner's construction and interpretation of the structure disclosed in the Fischer et al. reference:

Examiner's Interpretation 1: "a first housing (interpreted as the lower portion of housing 2201 that encompasses the rack 2206a) includes an axially extending first receptacle (interpreted as the forward portion of the first housing, the portion containing element 2213)."

Observation: The portion of housing 2201 that encompasses rack 2206a is the right-hand side of that housing, a cross-sectional view of which is shown in Fischer et al.'s Fig. 21b. Contrary to the examiner's interpretation, that right-hand portion does not contain element 2213 (a disk-shaped abutment), which, instead, is carried within the left-hand compartment of the structure, the part that extends to

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the left of the right-hand housing and that includes spring 2207, but does not include the rack. Rack 2206a, which is not cylindrical but has an L-shaped cross section, as clearly shown in Fig. 21b, is housed within the non-cylindrical housing 2201.

Examiner's Interpretation 2: "a toothed rack 2206a slides in a linear motion along a rack longitudinal axis in the first receptacle."

Observation: Agreed.

Examiner's Interpretation 3: "a second receptacle (interpreted as the rearward portion of the first housing, the portion containing element 2206b) in the first housing adjacent the first receptacle and within which second receptacle is a drive gear 2205, wherein a portion of the second receptacle intercepts the a portion of the first receptacle to define a space that is common to both (the space is interpreted as the passage that exists between the first and second receptacle), wherein the drive gear 2205 is in meshing engagement with the toothed rack for linearly moving the rack within the first receptacle;

Observation: Element 2206b is a complementary toothed rack and is also housed within the first receptacle identified by the examiner, along with toothed rack 2206a and drive gear 2205, not within a second receptacle. The so-called second receptacle does not intersect the first receptacle but is side-by-side with it. The receptacles are distinct from each other, although they share a common end wall that includes a passageway to allow the rack to move longitudinally from one receptacle to the other in response to rotation of drive gear 2205. The passageway, although connecting the receptacles, is not a space that is defined by

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an intersection of the first and second side-by-side receptacles, because the receptacles do not intersect, as claimed in the claims of the present application.

Examiner's Interpretation 4: "an electric motor 2202 is drivingly connected with the drive gear 2205, the drive gear is removably connected with the first housing (i.e. the drive gear can be removed from the first housing)."

Observation: The claims recite that the transmission housing is removably connected with the first housing, not the drive gear.

Examiner's Interpretation 5: "an energy accumulator 2207 is positioned between and in contact with the toothed rack and the first housing, wherein the toothed rack is movable in a first direction of movement that is opposite to a force imposed on the toothed rack by the energy accumulator and is movable in a second direction by the force of the energy accumulator, see column 37 lines 57-63, wherein the energy accumulator contacts the toothed rack at a first protrusion 2213 extending outwardly from the rack 2206a and is formed in a material locking connection.

Observation: Agreed.

The examiner acknowledged that "Fischer et al. fail to teach the construction of the overall housing element 2201, in particular having a transmission housing (such as containing worm gear 2203) removably connected from the first housing and connected with the output side of the electric motor 2202. The Bachnak et al. reference was cited for allegedly showing such a structure. But contrary to the examiner's interpretation, that reference does not allow easy access to the motor by removing housing 8 from housing 9. Figs. 2 and 3 of that reference show the

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structure of housings 8 and 9, respectively. The easy access to the motor is provided by removal of motor housing cover 11, not by the removal of housing 9 from housing 8. And the examiner's reference to column 1, lines 43-47 does not support his construction. Thus, the Bachnak et al. reference is not relevant to an assessment of the structure herein claimed.

Clearly, neither of the Fischer et al. nor the Bachnak et al. references, by themselves, teach or suggest the invention as it is claimed in claims 10 and 14. They do not show intersecting receptacles that define a space that is common to both receptacles as recited in claims 10 and 14. And further with respect to claim 14, they do not show or suggest a toothed rack that is supported in bearings at end areas of a first receptacle, nor do they show or suggest a journal bearing that also defines a stop for the spring.

Additionally, those references also do not contain any hint or suggestion that would motivate one having only ordinary skill in the art to combine them as the examiner has done. As noted above, each of the references relied upon by the examiner relates to a different structural arrangement and to a different problem than that to which the present invention is directed. And because of those differences, there would be no motivation to combine them.

It is important to note that the references do not contain any teaching or suggestion as to precisely how they could be combined to arrive at the invention as claimed. In that regard, it is not apparent from the references which features of which reference are to be combined with which features of the other reference. In short, the references do not contain any hints concerning

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how they could or should be combined, assuming one even wished to attempt to do so. Accordingly, the only motivation for combining the references in the manner the examiner has done is the disclosure of the present application. But it is an improper basis for rejection to use as a road map or as a template an inventor's disclosure to aid in picking and choosing particular parts of particular references that allegedly can be combined to render obvious that which only the inventor has taught. Thus, the invention as claimed is directed to an invention that is not obvious from the teachings of the references relied upon.

Although one could assert broadly, as the examiner has done, that there exists a motivation to make a combination of particular references in a particular way, such a mere broad assertion is insufficient. In that regard, it has been held that for there to be a sufficient showing of a motivation to combine the teachings of references, that motivation must be supported by referring to some relevant and identifiable source of information. Conclusory statements of possible advantages that would lead one to combine the teachings of several references, and assumptions of what an ordinarily skilled person would or would not do, are by themselves inadequate to support a conclusion that there exists a motivation to combine references in a particular way. In that regard, the Federal Circuit explained the matter thusly:

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with....The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that

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the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

In re Lee, 277 F.3d 1338 (Fed. Cir. 2002)

Consequently, the mere assertion of a subjective possible convenience that might be achieved by combining the teachings of different references is insufficient to support a conclusion of obviousness to combine.

The remaining claims each depend either from claim 10 or claim 14, either directly or indirectly, and therefore the same distinctions as are noted above in connection with claims 10 and 14 apply with equal effect to the dependent claims. Additionally, the dependent claims contain further recitations that define combinations of method steps that further distinguish over the disclosures of the references relied upon by the examiner.

Based upon the foregoing amendments and remarks, the claims as they now stand in the application are believed clearly to be in definite and allowable form in that they patentably distinguish over the teachings contained in the references that were cited and relied upon by the examiner. Consequently, this application is believed to be in condition for allowance, and reconsideration and reexamination of the application is respectfully requested with a view toward the issuance of an early Notice of Allowance.

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The examiner is cordially invited to telephone the undersigned attorney if this amendment raises any questions, so that any such question can be quickly resolved in order that the present application can proceed toward allowance.

If after consideration of the amendments, observations, and arguments presented above the examiner continues to maintain his final rejection of the claims, it is requested that this Amendment be entered on the basis it does not raise new substantive issues, in view of the minor nature of the claim amendments reflected above, but presents the claims in better form for appeal.

Respectfully submitted,



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